

Serial No. 09/829,536
Attorney Ref. No. 1205-007/JRD
Reply to Office Action Dated: December 28, 2005

REMARKS

A final Office Action, dated December 28, 2005, rejects pending claims 1-6 and 8-10. Claims 1 and 5, 6, 8-10, 13, and 14 have been amended herein, and claims 11 and 12 have been cancelled herein. Reconsideration is respectfully requested in light of the foregoing amendments and the following remarks.

Specification Objections

Applicants have amended the specification as noted herein to address the informalities cited by the examiner.

35 USC § 112 (First Paragraph)

Applicants respectfully traverse the examiner's 35 U.S.C. 112 (first paragraph) objections. FIG. 6C shows a plurality of a customer's prescription orders being bundled together in a common carrier. The elements of claims 1 and 5 are also discussed at length throughout the specification. For example, please see page 10, lines 12 through page 11, lines 28.

Should the examiner continue to maintain this rejection, applicants ask that the examiner specifically identify the element or elements of each claim that the examiner considers missing from the specification so that the applicants can respond with more pin-point citations to the specification and drawings.

35 USC § 103

The claims stand rejected under 35 USC § 103 for obviousness over U.S. Pat. No. 6,464,142 to Denenberg ("Denenberg") in view of McCullough et al., Markman and Engellenner et al. Applicants respond as follows.

1. No teaching or suggestion to bundle a customer's prescription order into a common carrier.

As currently amended, all of the pending claims include limitations that the plurality of prescription orders for the same customer be grouped together in a common carrier and electronically associated with each other. As explained more fully in the specification of the present application, this bundling facilitates tracking through the pharmacy and retrieval of all of the customer's filled prescription orders upon pickup.

Serial No. 09/829,536

Attorney Ref. No. 1205-007/JRD

Reply to Office Action Dated: December 28, 2005

Applicants maintain that none of the references of record teach or suggest such features. U.S. Patent No. 5,794,213 to Markman ("Markman") individually labels and tracks each item in a customer's order as they are separated from each other during various laundry cleaning processes. The tracking system in Markman merely facilitates collection of all of a customer's items prior to pick-up. Moreover, there is no teaching or suggestion in Markman to use any alleged "bundling" to bundle a customer's prescription orders in a pharmacy.

Denenberg is directed to a will call system that uses optical scanners to scan bar codes that are placed on prescriptions in a pharmacy. As illustrated in Fig. 3 of Denenberg (reproduced below), a single bar code scanner 50 is used for a cabinet 15 of storage locations 13.

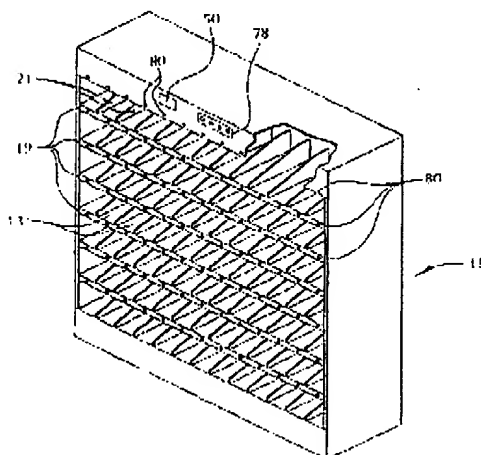


FIG. 3

In operation, a worker scans the bar-coded prescription in front of the bar code scanner 50 and places the prescription in the location 13 indicated by the system. As illustrated in Figs. 5A and 5B (reproduced below), the storage location 13 may include an article sensor 23 that can detect that an article is placed in the storage location by disruption of a light beam from a light source 24.

Serial No. 09/829,536

Attorney Ref. No. 1205-007/JRD

Reply to Office Action Dated: December 28, 2005

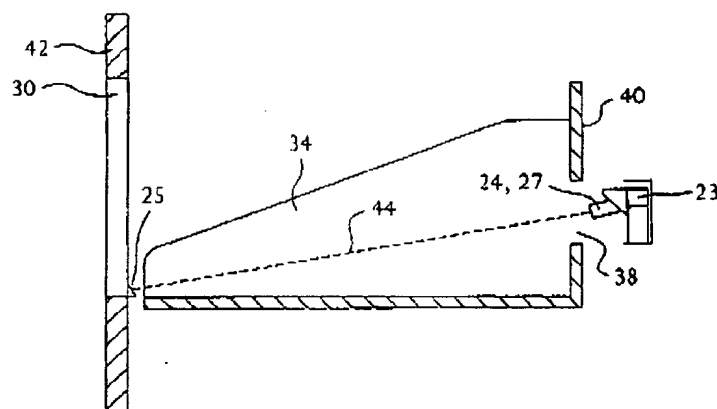


FIG. 5A

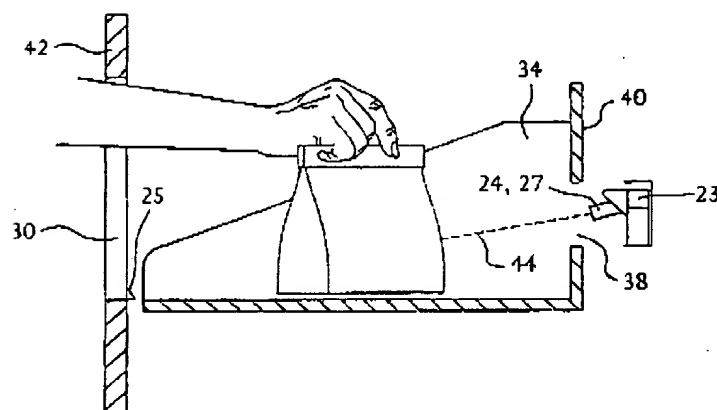


FIG. 5B

Independent claims 1 and 5 have been amended herein to clarify that a common carrier containing a bundle of a customer's prescription orders is tagged with a machine-readable tag. Denenberg does not teach or suggest such prescription order tracking, whether alone or in combination with any of the cited references. Denenberg describes a single bar code scanner in front of which a worker must hold a bar-coded prescription before placing the prescription in a storage location. While in the storage unit of Denenberg, a bar-coded prescription is no longer identifiable by the system. The article sensor of Denenberg detects that something is in a storage location, but does

Serial No. 09/829,536
Attorney Ref. No. 1205-007/JRD
Reply to Office Action Dated: December 28, 2005

not specifically read the bar code on the prescription in the storage location. For example, a harried worker holding many prescriptions could inadvertently scan one prescription and place another in the indicated storage location. As a result, Denenberg fails to provide a complete "chain of custody" of the filled prescription in storage and thereby fails to provide a fail-safe identification of which prescription is located in each location.

In contrast, independent claims 1 and 5 specifically recite that a machine-readable tag is secured to each storage carrier containing a customer's bundle of prescription orders. Accordingly, applicants submit that claims 1 and 5 are patentably distinct from the cited references and request that the claims be allowed. Applicants submit that the claims depending from claims 1 and 5 are allowable as dependents of allowable base claims. In addition, applicants submit that selected ones of the base claims are allowable for the following additional reasons.

2. No references of record teach or suggest "automatic" detection of prescription orders.

As currently amended, independent claims 1 and 5 include limitations to automatically detecting a prescription order. As explained more fully in the specification of the present application, such automatic detection eliminates a primary cause of pharmacy worker error—the worker failing to properly operating the scanning device.

Applicants maintain that Denenberg teaches away from automatic tracking of prescription orders by disclosing how pharmacy workers must first operate a common scanner to read each individual prescription and then receive and follow instructions from a computer system as to where that prescription must be placed in the storage device.

In light of the foregoing distinction, applicants maintain that independent claims 1 and 5 are now in condition for allowance. Moreover, since dependent claims 2-4, 6, and 8-10, and 12-20 depend on one of these now allowable claims, they too should be in condition for allowance.

As currently amended, all of the pending claims include limitations that the plurality of prescription orders for the same customer be grouped together in a common carrier and electronically associated with each other. As explained more fully in the

Serial No. 09/829,536

Attorney Ref. No. 1205-007/JRD

Reply to Office Action Dated: December 28, 2005

specification of the present application, this bundling facilitates tracking through the pharmacy and retrieval of all of the customer's filled prescription orders upon pickup.

Applicants continue to maintain that none of the references of record teach or suggest such features. U.S. Patent No. 5,794,213 to Markman ("Markman") individually labels and tracks each item in a customer's order as they are separated from each other during various laundry cleaning processes. The tracking system in Markman merely facilitates collection of all of a customer's items prior to pick-up.

In contrast to Markman, the present invention bundles all of a customer's prescription orders together in a common carrier and tracks the common carrier through the pharmacy. No references of record, including Markman and Denenberg, teach or suggest such a feature.

3. No teaching to combine references

Similarly, while McCullough discloses a customer notification display system, there is no teaching or suggestion in any references of record to use such a system in a pharmacy in accordance with the limitations of claims 2-4 and 16-19. Accordingly, these claims should also be allowable on these grounds.


Similarly, no references of record teach or suggest using any automatic tracking structures for automatically tracking prescription orders, much less a bundle of prescription orders, through a pharmacy.

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

January 29, 2007

By


John R. Dawson
Registration No. 39,504

ipsolon llp
111 SW Columbia St., Ste 710
Portland, Oregon 97201
Phone No. (503) 419-0702
Fax No. (503) 249-7068
E-Mail: john@ipsolon.com